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AUG 30 1943

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IN THE
Supreme Court of the United States

OCTOBER TERM, 1943.

No. 210

RICHARD W. WERNER,

Petitioner,

vs.

HEIN-WERNER MOTOR PARTS CORPORATION,
A WISCONSIN CORPORATION,

Respondent.

**BRIEF FOR RESPONDENT IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI.**

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August 28, 1943.

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**BRIEF FOR RESPONDENT IN OPPOSITION TO
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The Circuit Court of Appeals for the Seventh Circuit found Werner Patent No. 2,038,974 not infringed by the hydraulic jack accused, and the patentee petitions for review on writ of certiorari.

Respondent opposes the petition.

This is a plain case of a finding of non-infringement, on the facts and under well-settled law.

The trial court and the court of review found, as a fact, that

“There is no identity of result or substantial identity of means.” (Tr. pp. 149, 276.)

That, under the law, spells non-infringement.

There is nothing involved warranting the attention of this Court.

Keller v. Adams-Campbell Co., 264 U. S. 314, 318, 319.

Layne &c. Co. v. Western Well Works, 261 U. S. 387, 388, 392, 393.

There is no conflict as alleged (Petition, p. 6), nor is there involved any unsettled question of federal law (Petition, p. 6).

Petitions for writs of certiorari are not granted merely to give the defeated party in the Circuit Court of Appeals another hearing.

American Construction Company v. Jacksonville, Tampa and Key West Railway Company, 148 U. S. 372, 382.

Magnum Import Company, Inc. v. Coty, 262 U. S. 159, 163.

Referring now to petitioner's "Summary Statement of Matter Involved" (Petition, pp. 2-5), point by point:

1.

The main issue in this case was that of infringement,—*i. e.*, what was the alleged invention disclosed by the patentee, and did the defendant appropriate it?—and "claim interpretation" (Petition, p. 2) was involved simply as the usual adjunct to that question.

2.

It is not correct to say that validity of the claim "has not been seriously challenged" (Petition, p. 2). It was defendant's position that the claim was invalid because it did not comply with Section 4888 of the Revised Statutes

and because it lacked the quality of invention over the prior art; the trial court and the court of review did not pass upon either of these issues because their findings of non-infringement were determinative of the case (Tr. pp. 146, 149, 273, 276).

3.

The claim is not "applicable verbatim" to the accused jack (Petition, p. 2). Even if it were, that alone would not be the test.

Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568.

Petitioner states that the trial court and the court of review found non-infringement "on the basis of an interpretation of the claim which involves the reading into the claim of a limitation not expressed therein" (Petition, pp. 2, 3).

That is not correct.

The courts simply read and interpreted the claim in the light of the specification and drawings, as required by law.

Schriber Co. v. Cleveland Trust Co., 311 U. S. 211, 217.

Snow v. Lake Shore, &c., Railway Co., 121 U. S. 617, 628-630.

4.

Petitioner says (Petition, p. 3):

"A major feature of the jack of the patent is the oblique angular position of the pump chamber, *whereby* it is intermediate the vertical ram cylinder and the almost horizontal release duct." (Italics supplied.)

as if "oblique angular position of the pump chamber" and "intermediate the vertical ram cylinder and the almost horizontal release duct" meant one and the same thing, the latter merely explanatory of the former.

An oblique pump chamber either may or may not be intermediate the ram cylinder and the release duct.

In the patent there is an oblique pump chamber and it is intermediate the ram cylinder and the release duct.

And the claim says:

“a pump chamber formed in said base and opening therefrom along an axis inclined with reference to said cylinder *and* intermediate said cylinder and said duct.” (Tr. p. 161, col. 2, lines 39-42.) (*Italics supplied.*)

5.

Petitioner states that the combination of the claim makes possible a reduction in the number of plugs exposed to high pressure (Petition, p. 3). In fact, it *eliminates* plugs exposed to high pressure; that was the object of the patentee (Patent, p. 1, col. 1, lines 22-40, Tr. p. 159).

Petitioner also states that the combination of the claim “permits the ram cylinder to be centered on the jack base” (Petition, p. 3). The ram cylinder of the patent is no more centered than in prior art instances (Tr. pp. 164, 198, 216, 263), and the patent specification makes no point of any such feature.

6.

Petitioner states (Petition, p. 3):

“Respondent’s accused jack was designed before issue of Petitioners’ patent with full knowledge of Petitioner’s invention, which had been disclosed to Respondent by Petitioner in connection with the offer of a license (Tr. p. 18).”

Respondent’s jack was designed before issue of petitioner’s patent. Beyond that, the statement is mere assertion by counsel without foundation in the record. The citation of page 18 of the Transcript is itself enough to show the lack of evidence in this regard.

Respondent's jack does not use the intermediately located pump chamber of the patent in suit.

Nor does it achieve the purposes of the alleged invention at bar.

There is no point here in merely reducing the number of plugs. Defendant had twice previously reduced the number of its plugs, always by the same shop technique.

Respondent based its contention of non-infringement on the fact that its jack is characterized by an utterly different principle of construction from that of the patent in suit, and on the lack of that substantial identity of means and identity of result which are essential to infringement.

Yale Lock Company v. Sargent, 117 U. S. 373, 378.

Werner v. King, 96 U. S. 218, 230.

Burr v. Duryee, 68 U. S. 531, 572, 573.

Kokomo Fence Machine Co. v. Kitselman, 189 U. S. 8, 24.

There is nothing "slight" about the offset to which petitioner refers. It is a very substantial offset, indigenous to an utterly different rationale of device than that of the patent. Respondent is not making point of mathematical exactness. A "slight" or "colorable" offset would be one that would not change the principle of construction. Here the principles of construction of the two devices are utterly different.

Nor is this a case of imperfect practice of an invention. Here, respondent does not practice the invention at bar at all.

9.

Any novelty that can be predicated of location of the pump chamber of the patent intermediate the ram cylinder and the release duct must be a matter of its geographic location, and whatever function is performed because of that location becomes an essential characteristic of the patent. That function is due to the placing of all three in the same plane, whereby cross-drilling and external plugging incident thereto are dispensed with.

The pump chamber of respondent's jack is not geographically and functionally intermediate the ram cylinder and the release duct, in the sense in which the term "intermediate" is normally used, and certainly in the sense in which it is used in the patent claim.

There is but one objective of the patent, at least so far as the claim in suit is concerned, and that is to do away with high pressure plugs; and respondent's jack does not achieve that objective. It avoids leakage by careful shop practice in making its plugs tight.

The provisions of Claim 6 of the patent in suit that the pump chamber be intermediate the cylinder and the release duct can mean nothing other than that the three be co-planar, and the trial court and the court of review correctly found that respondent's jack did not infringe.

10.

The Caldwell Patent 569,574 (Tr. p. 176) is a prior art instance of an inclined pump chamber intermediate the ram cylinder and the release duct,—though in this instance the reservoir surrounds the pump chamber instead of the ram cylinder.

Petitioner argues as if anything and everything shown in his patent, not duplicate of the prior art, is an invention and covered by his claim.

Respondent's position is that the claim can cover only an invention taught by the disclosure.

11.

Petitioner states that during pendency of the application for the patent in suit, claims referring to the location of the ducts in a single plane "were considered" (Petition p. 5).

What it amounts to, and all it amounts to, is that, at one time, claims using the phraseology—"a plurality of conduits formed in said mass substantially in a vertical plane"—were submitted, rejected, and cancelled for reasons applicable to the claims as a whole.

Petitioner's argument is that the fact that the claim in suit does not employ that phraseology "indicates intent on the part of the Commissioner of Patents not to qualify the allowed claim in this respect" (Petition, p. 5).

No such conclusion follows, and there is no such doctrine.

Respondent's position is that saying that the pump chamber is intermediate the cylinder and the release duct is just another way of saying that the three are in the same plane.

12.

Petitioner asserts that "The invention in controversy has been extensively recognized by the industry" (Petition, p. 5).

That is not correct.

(a)

Petitioner's one licensee has made and sold some 100,000 to 125,000 jacks, like the patent (Tr. p. 139), over a period of about eight years. It made a great many more jacks upon which it paid no royalties and as to which it declines to comply with petitioner's demand for royalties; in other

words, petitioner's licensee not only does not recognize the patent in suit beyond the construction which the patent illustrates; it refuses to do so (R. p. 33).

(b)

As to the "Two large jack manufacturers" who are said to have copied plaintiff's construction and, when charged with infringement, to have "changed their construction in recognition of the patent" (Petition, p. 5), it will be seen from the cited references to the transcript, that nothing either pertinent or material is established. Moreover the accused products of those manufacturers had their cylinders, pumps, and ducts in the same plane, and it may have been prudent on their part to drop that design; but that has nothing to do with this case.

(c)

Respondent's jacks do not embody the alleged invention of the patent.

Under "Questions Presented" (Petition, p. 5), petitioner presents a single question, phrased broadly as follows:

"In the complete absence of prior art requiring a narrow interpretation, is the Court justified in basing a finding of non-infringement upon a limitation not specifically recited in the claim but read into the claim by the Court?"

Firstly, as already stated, petitioner argues as if anything and everything shown in his patent, not duplicate of the prior art, is an invention and covered by his claim,—certainly an untenable position.

Secondly, the trial court and the court of review did not find non-infringement upon a limitation not specifically recited in the claim. The limitation upon which they found non-infringement is specifically recited in the claim. The courts did not "read" anything "into" the claim. They

merely read the claim in the light of the disclosure, as required by law.

Schriber Co. v. Cleveland Trust Co., 311 U. S. 211, 217.

Snow v. Lake Shore &c. Railway Co., 121 U. S. 617, 628-630.

Petitioner's "specific" phrasing of the question presented is replete with controverted assertions.

The alleged invention is not important.

It made no "significant impact on the industry."

The trial court and the court of review did not base their finding of non-infringement upon something not expressed in the claim "but which the Court arbitrarily supplied." The claim, in fully equivalent language, calls for the planar relationship taught by the patentee,—which respondent does not have.

The claim is not applicable verbatim to the accused structure. Nor is it applicable in substance or spirit.

There was no appropriation by respondent of the alleged invention of the patent, and no realization of its objective or objectives.

Under the heading "Reasons for Grant of Writ of Certiorari" (Petition, p. 6), petitioner asserts (1) conflict between the decision rendered in this case by the Circuit Court of Appeals for the Seventh Circuit and the decisions in the following cases:

(a) *Cincinnati Cadillac Co. v. English Mersick Co.*, 18 Fed. (2d) 542, C. C. A. Sixth Circuit;

(b) *Samson-United Corporation v. Sears Roebuck & Co., Inc.*, 103 Fed. (2d) 312, C. C. A. Second Circuit; and

(c) *Kansas City Southern Railway Co. v. Silica Products Co.*, 48 Fed. (2d) 503.

There is no conflict.

(a)

Re Cincinnati Cadillac Co. v. English Mersick Co.:

This decision, in this regard, simply holds that courts are without power to enlarge or restrict a claim for the purpose of making out a case of validity or infringement.

The courts in the instant case assumed no such power. They simply followed the law which the Court in the *Cincinnati v. English* case goes on to refer to,—i. e., that they may construe the claim in the light of the specifications and the prior art “for the purpose of making it operative or ascertaining its true meaning,”—citing, in this latter connection, the opinion of this Court in *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537 (See pp. 557, 558).

(b)

Counsel for petitioner does not explain his point in respect of the *Samson-United v. Sears Roebuck* case, and we do not see what his point could be. As we see it, it is simply a holding of validity and infringement on the particular facts of that case.

(c)

The point which petitioner makes of the *Kansas City Southern v. Silica Products* case is that it holds that “One does not escape infringement by practicing invention imperfectly.” There the defendants “followed the process of the patent with substantial closeness,” and the fact that their product was inferior was held to be immaterial. Here, the defendant neither uses the principle of nor accomplishes the object of the patent.

The petitioner (Petition, p. 6) also asserts (2) that “the Circuit Court of Appeals for the Seventh Circuit has decided an important question of federal law which has not

been, but should be, settled by this court and as to which the decision of the Seventh Circuit Court of Appeals is probably in conflict with decisions of this Court insofar as the same are applicable."

As to the first portion of the foregoing, we simply state again that all that that Circuit Court of Appeals did in this case was to find non-infringement on the facts and under well settled law.

As to the latter portion, we are not sure that we know what it means; it appears to say that the decision of the Circuit Court of Appeals fails to follow the decisions of this Court, but we submit that it is clear that that is not correct.

Petitioner's "Brief in Support of Petition for Writ of Certiorari" is really re-argument of the case. It comprises (including drawings) eighteen pages. (His main brief in the Circuit Court of Appeals comprised, including drawings, seventeen pages, his reply brief five.)

That we do not consider in compliance with the Rules, and we do not reply to its detail.

We content ourselves with presenting three drawings of defendant's device which, we submit, speak for themselves.

The drawing which appears opposite page 12 of petitioner's brief is *not* Defendant's Exhibit K as stated by petitioner on page 12.

It is Plaintiff's Exhibit 16, and, in the trial court and in the court of review, we criticized that exhibit as insufficiently illustrative and submitted defendant's illustrations, Defendant's Exhibits K and L, hereto annexed, in order fully to inform those courts.

We also criticize the drawing opposite page 16 of petitioner's brief. It is illusory. It is a diagram, in elevation from *the side only*, and which therefore makes it appear as if the three axes are in one plane, which would mean a pump chamber intermediate the ram cylinder and the release duct.

But we are, of course, dealing with a three-dimensional object, and, when we look at a companion elevation of *the front* of the device (*i. e.*, 90° from the plane of projection of petitioner's diagram), we get a very different picture, which we submit opposite this page.

CONCLUSION.

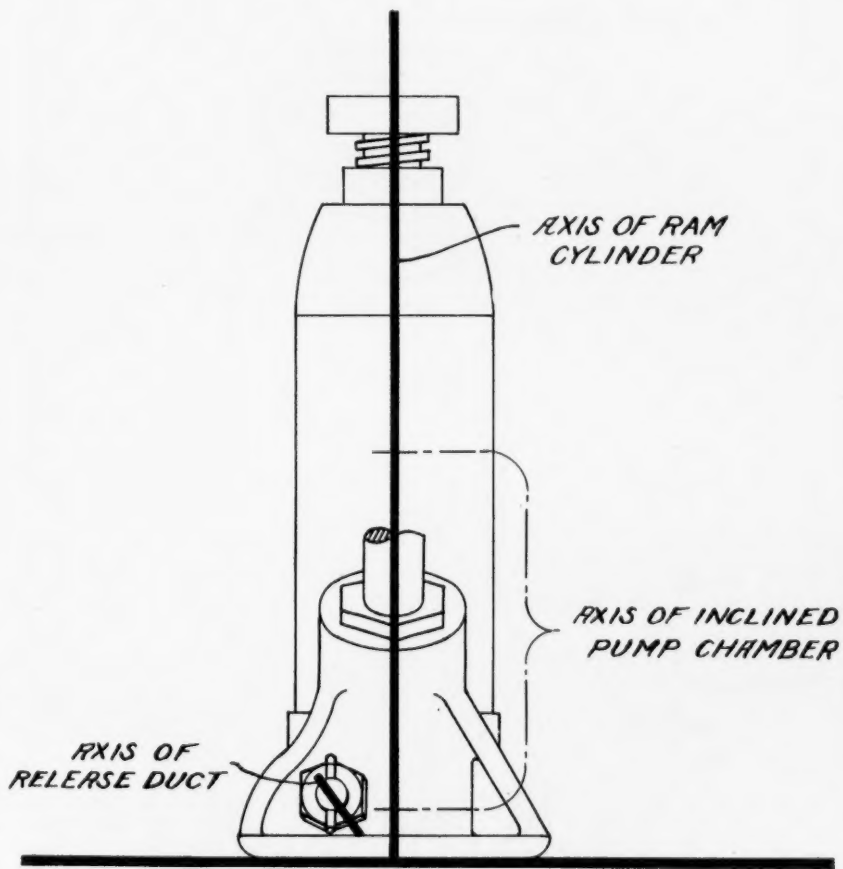
The petition for a writ of certiorari should be denied.

Respectfully submitted,

ARTHUR H. BOETTCHER,

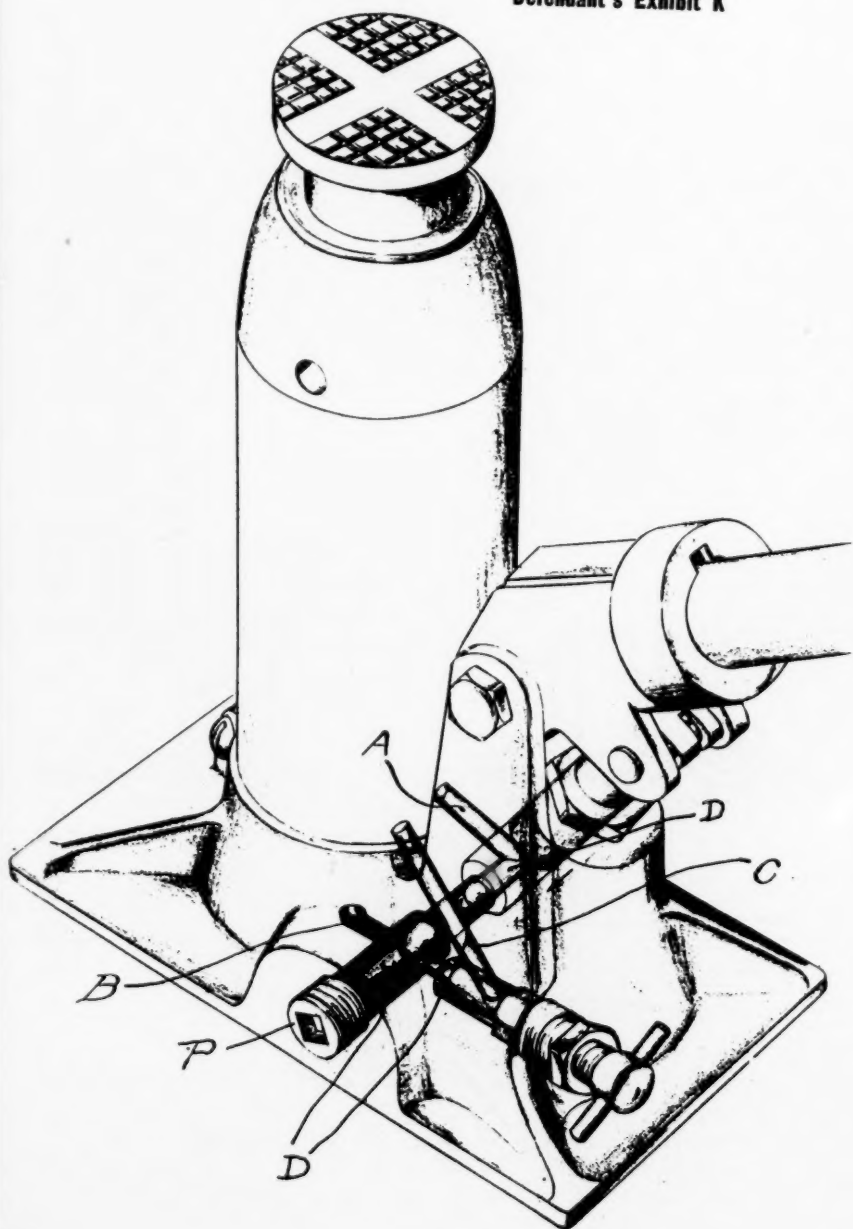
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DEFENDANT'S DEVICE

Defendant's Exhibit K



Defendant's Exhibit L

DEFENDANT'S DEVICE

